REMARKS

Claims 31-53 are pending in the application. Claims 31-53 stand rejected. Applicant herein amend claims 31, 38, 45, 52. No new matter has been added. Further review is respectfully requested in view of the amendments and following remarks.

I. Rejection of Claims 31, 38, and 45 Under 35 U.S.C. § 101

Claims 31, 38, and 45 stand rejected under 35 U.S.C. §101 because the Examiner asserts that the claims "do not produce a useful, concrete and tangible result." (Office Action pg 2). Applicants' representative respectfully submit that the "useful, concrete and tangible result" test is no longer sufficient for determining whether a claim satisfies §101. Rather, the proper test is be the machine-or-transformation test. *In re Bilski, __ F.3d __ , 20* (Fed. Cir. 2008)(en banc).

> " [T]he proper inquiry under §101 is not whether the process claim recites sufficient "physical steps," but rather whether the claim meets the machine-or-transformation test… a claim that purportedly lacks any "physical steps" but is still tied to a machine or achieves an eligible transformation passes muster under §101." (*In re Bilski at 23.)* "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his ***claim is tied to a particular machine***, or by showing that his claim transform an article." *(Id. at 10, citing Gottschalk v. Benson, 409 U.S. 63, 70, 93 S. Ct. 253, 34 L. Ed. 2d 273 (1972)).*(emphasis added).

As is clear from the claim language, all the steps as recited by claim 31 (and similarly claims 38 and 45) are tied to a machine. (e.g., "instantiating ***a data base*** of electronic receipts coupled to a ***server***…" "receiving, ***at the server***…" and "transmitting, from ***the server***…") More importantly, the steps involve the transfer of electronic receipts. At least one computer device is required by claim 1 in order to efficiently and effectively obtain the correct receipt and send it to a remote device and thus is not a insignificant part of the claim. (*See Parker v. Flook, 437 U.S. 584, 590, 98 S. Ct. 2522, 57 L. Ed. 2d 451 (1978).* Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 31-53 Under 35 U.S.C. § 103

Claims 31-53 stand rejected under 35 U.S.C. §103(a) over Mäkipää *et. al.* US 6,394,341 ("Mäkipää") in view of Hoffman *et. al.* US 2002/0109007 ("Hoffman"). Withdrawal of this rejection is respectfully requested for at least the following reasons. Mäkipää is not properly combinable to establish a *prima facie* case of obviousness, and Hoffman fails to disclose, teach, or suggest all claimed features.

The subject claims relate to methods and devices for accumulating purchase transaction data for a receipt cardholder. More particularly, the receipt card account number is provided to retailers (e.g, by presenting the receipt card at the time of purchase, or by providing the receipt card account number verbally or through a keypad) in the form of a card whereby the retailer will accumulate line item transaction data. To this end, independent claim 31 (and similarly, claims 38, 45, and 52), as amended recites: "*each receipt associated with a receipt card having a magnetic strip encoded with information that identifies an electronic address of the database and information that identifies a receipt card account number*."

The Examiner concedes that Mäkipää does not disclose or teach at least such claimed aspect of the subject invention. Instead, the Examiner contends that Hoffman teaches the receipt card feature as recited in claim 31. However, Applicants' representative respectfully disagrees because Hoffman fails to disclose, teach, or suggest at least such claimed aspect of the subject invention.

Hoffman relates to apparatus and methods for providing a consumer means to access a digital receipt generated as a result of a single purchase transaction. In one example, Hoffman discloses a retail terminal that is operable to: 1) produce a digital receipt corresponding to a purchase transaction; 2) obtain a network address corresponding to a storage location of the digital receipt; 3) store the digital receipt at the network address; 4) provide the network address to the printer; and 5) print the network address in the machine-readable form. ([0011]). However, Hoffman is silent with regards to "*each receipt associated with a receipt card having a magnetic strip encoded with information that identifies an electronic address of the database and* ***information that identifies a receipt card account number***."

In clear contrast, Hoffman merely discloses a system that generates and saves digital receipts for individual stores. Thereafter, a customers can access the digital version of their receipt online. However, while a customer may be given a card with encoded information about each transaction, this card is not linked to any account. If a customer made several transactions, the customer will be given several encoded cards; one for each individual transaction.

According to Hoffman, "the paper receipt is given to and retained by the consumer while the digital receipt is forwarded to a storage location… ***the digital receipt is assigned a storage address*** that is accessible via the network by a network enabled apparatus… Additionally, ***the address for the stored digital receipt is encoded or printed onto the paper receipt***… The address may also be encoded onto a magnetic strip such as is readable by a card reader." ([0034]). Thus, it appears that after each new transaction, a consumer under Hoffman's system will receive a new encoded card containing a new address for the digital receipt because each new transaction will generate a new address. Most importantly, this also indicates that Hoffman fails to teach a receipt card that indentifies a receipt card account number. As depicted in Figure 1, each store (12) in the Hoffman system will have its own system for assigning digital receipts. Thus, there will be no receipt card account number since each transaction is a separate event. Thus, Hoffman cannot be said to teach or suggest: "*each receipt associated with a receipt card having a magnetic strip encoded with information that identifies an electronic address of the database and* ***information that identifies a receipt card account number***" as recite in claims 31, 38, 45, and 52.

In view of at least the foregoing, Mäkipää is not properly combinable for the purpose of establishing a *prima facie* case of obviousness. Hoffmna also fails to disclose or suggest at least the above-identified features. Accordingly, reconsideration and withdrawal of the outstanding rejection to claims 31, 38, 45 and 52 is respectfully requested. Each of claims 32-37, 39-44, and 46-52 depend directly or in directly from independent claims 31, 38, 45 and 52, respectively, and are believed allowable for the same reasons.

CONCLUSION

Applicants request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

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/Amy O. Kwan/
Amy O. Kwan
Registration No. 59,829

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439